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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,930	09/19/2001	Tsuyoshi Hiramatsu	3273-0146P	3012

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/936,930	HIRAMATSU ET AL.	
	Examiner	Art Unit	
	Victor S Chang	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 8, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 8, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 6/10/2004. Applicants' amendments to the specification, claims 2, 3, 8, 22 and 23, cancellation of claims 1, 4-7 and 9-21 have been entered. It should be noted that Applicants' statement "claims 1-3 ... are pending" (Remarks, page 6) appears to be a typo, since claim 1 is listed as "(cancelled)" on page 2 of the amendments, and its recitation has not been repeated.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, in view of the amendments, the rejections under 35 USC 112 in sections 5-7 of Office action mailed 10/15/2003 are withdrawn. Additionally, Applicants' argument "Comparative Example 3 clearly shows a pressure-sensitive adhesive sheet may have a certain amount of initial tackiness, but that such initial tack has no relation to the solvent absorption or tackiness thereafter as instantly claimed" (Remarks, page 15) is persuasive. As such, the prior 103(a) rejection over Applicants' admitted prior art is also withdrawn. However, Applicants' arguments are moot in view of the new grounds of rejection as follows.

Claim Rejections - 35 USC § 112

4. Claims 2, 8 and 20-23 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

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which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner repeats (see Office action mailed 10/15/2003) the recitation "excluding a foaming pressure sensitive adhesive layer" in claim 1 lacks express or inherent support in the specification, and appears to be "new matter", and cancellation is required. In response to Applicants' argument "Based on the present specification and the Examples, there are multiple instances of not including a foaming pressure sensitive adhesive layer. Thus the concept of excluding the foaming pressure sensitive adhesive layer is within Applicants' invention." (Remarks, page 11), the Examiner notes that none of the Examples expressly teaches "excluding a foaming pressure sensitive layer", and it should be noted that the mere absence of a positive recitation is not basis for an exclusion. See MPEP 2173.05(i). The Examiner would like to suggest that a positive recitation, such as "wherein the pressure sensitive adhesive layer is solid and comprises an adhesive of either (A) or (B):", may be an acceptable format.

5. Claim 2, at least, is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, line 4, the term "foaming" appears to be vague and indefinite, because the term is absent from the specification, so it is unclear as to what is the scope of "foaming", also it is unclear to the Examiner as to how a pressure sensitive layer can be continuously "foaming"? Clarification is requested.

Response to Amendment

6. Claims 2, 3, 8, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-254656 (Computer Translation).

JP '656 is directed to a screen printing plate cleaning sheet, which consists of a base layer 2 and a foam layer 3 (Drawing), a coating of self-adhesive (pressure sensitive adhesive) is applied to the surface of the foam layer 3. The cleaning sheet is pasted to the screen printing plate to adhere and absorb the ink, so as to remove the ink from the printing plate (Abstract). Suitable adhesives include natural rubber, styrene butadiene rubber, polyisobutylene, styrene-isoprene-styrene block copolymer, acrylic resin (such as a copolymer of acrylic acid and C₂-C₁₀ alkyl ester), styrene-acrylic ester copolymer, etc. (paragraph 0008). Further, JP '656 expressly teaches that the tackiness of the adhesive layer is 1-200 gf/25-mm (JIS-Z-0237).

For claims 2, 3 and 8, JP '656 is silent about the solvent absorption rate from the ink, the monomer composition ratio in the acrylic adhesive; and it is noted that the unit of the tackiness appears to be written in an alternative equivalent unit. However, since JP '656 teaches essentially the same subject matter as the instant invention, it is the Examiner's position that, in the absence of unexpected results, the aforementioned elements are believed to be either anticipated by JP '656, or obvious optimization to one of ordinary skill in the art, motivated by the desire to cleanly remove the printing plate. It should be noted that where the claimed and prior art products are shown to be identical or substantially identical in structure or composition, or are produced by identical or

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substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01.

For claim 22, JP '656 lacks a teaching that the pressure sensitive adhesive contains a crosslinking agent. However, JP '656 does teach that crosslinking agent may be contained in foam layer 3 (paragraph 0009). Additionally, regarding the crosslinking agent, the Examiner notes that the well-known in the art statement in the prior Office action mailed on 10/15/2003 is taken to be admitted prior art because Applicant either failed to traverse the Examiner's assertion of official notice or that the traverse was inadequate. See MPEP § 2144.03.C. As such, the Examiner repeats that it would have been an obvious optimization to one of ordinary skill in the art to incorporate a crosslinking agent in the pressure sensitive adhesive, motivated by the desire to improve the cohesive strength of the adhesive for absorbing the solvents.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interest for making pressure sensitive cleaning sheet:

Tanaka et al. (US 6555192) is directed to a PSA cleaning sheet for cleaning image-forming apparatus, including printer.

Inaba et al. (US 4634629 and US 4746388) is directed to an lift-off adhesive tape for removal of correctable ink.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VSC

Victor S Chang
Examiner
Art Unit 1771

7/16/2004


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700